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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,901	10/31/2001	Werner Lindemann	112740-350	2923

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BELL, BOYD & LLOYD, LLC  
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CHICAGO, IL 60690-1135

EXAMINER
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AILES, BENJAMIN A

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/682,901

Applicant(s)

LINDEMANN ET AL.

Examiner

Benjamin A. Ailes

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to correspondence filed 23 August 2006. Claims 1-15 remain pending.
2. In view of the Pre-brief conference request filed on 23 August 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities:
- Claim 1, line 10, "...the select conversion device..." should be changed to "...the selected conversion device..."

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia et al. (US 6,118,768), hereinafter referred to as Bhatia, in view of Guerin et al. (US 6,243,754 B1), hereinafter referred to as Guerin.

8. Regarding claims 1 and 12, Bhatia teaches a method/router device for setting up a connection via an IP-oriented network, the method comprising the steps of connecting

Art Unit: 2142

a device (USER), from which the connection originates, to a local computer network (ETHERNET) and connecting the local computer network via a router device (LAN modem 300 w/ router 305) to a communications network (col. 10, ll. 19-42). Bhatia teaches the connecting of a device to an IP oriented network but does not explicitly teach "connecting the communications network via a plurality of conversion devices to the IP-oriented network; selecting any one of the conversion devices by said device, via a selection unit implemented in the router device, using information transferred by the device, wherein the information identifies the selected one of the conversion devices; and setting up a communications link to the select conversion device via the communications network." However, in related art, Guerin teaches on these remaining limitations. Guerin teaches connecting the communications network via a plurality of conversion devices to the IP-oriented network (col. 3, ll. 7-11 and Figure 1); selecting any one of the conversion devices by said device, via a selection unit implemented in the router device, using information transferred by the device, wherein the information identifies the selected one of the conversion devices (col. 3, ll. 14-21 and Figure 2a); and setting up a communications link to the select conversion device via the communications network (col. 3, ll. 14-21). One of ordinary skill in the art at the time of the applicants' invention would have found it obvious to combine the teachings of Bhatia with the teachings of Guerin. One of ordinary skill in the art would have been motivated to implement the ability for an originating device to select an appropriate service provider from different possible choices as taught by Guerin in order to maximize cost, quality of service and pre-established business contracts when selecting an appropriate

service providers as taught by Guerin in column 3, ll. 20-24, in combination with the connection configuration and establishment as taught by Bhatia.

9. Regarding claim 2, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, wherein the selected conversion device is a default conversion device, a communications link being set up via the default conversion device in cases where no information to the contrary is received in the selection unit (Guerin, col. 3, ll. 24-29).

10. Regarding claim 3, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, the method further comprising the steps of:

initializing a connection setup by a first application running on the device (col. 3, ll. 14-16); and

transferring the information originating from a second application running on any given device to the router device (Guerin, col. 3, ll. 16-20).

11. Regarding claim 4, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, wherein the information is transferred via a separate connection via the local computer network (Guerin, col. 3, ll. 14-16).

12. Regarding claim 5, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

transmitting automatically, via the selection unit, a request message to the device which is transmitting the information in cases where no information is received in the selection unit (Guerin, col. 3, ll. 16-20).

13. Regarding claim 6, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network wherein the default conversion device is configured by the selection unit as a function of time of day (Guerin, col. 3, lines 9-20).

14. Regarding claim 7, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

automatically clearing down an existing communications connection between the device and a different conversion device at an end of a definable time period in cases where a new communications connection is set up between the device and a conversion device (Bhatia, col. 34, lines 58-65).

15. Regarding claim 8, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network wherein the existing communications connection is not cleared down in cases where a different device connected to the local computer network continues to access this communications connection (Guerin, col. 5, ll. 44-50)

16. Regarding claim 9, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, the method further comprising the steps of:

designing the selection unit according to a Domain Name Service proxy, wherein a Domain Name Service enquiry transferred from the device to the selection unit is checked to ascertain whether an Internet name corresponding to the Domain Name Service enquiry and identifying a conversion device is stored in the selection unit (Guerin, col. 3, ll. 24-29); and

forwarding the Domain Name Service enquiry, if the internet name is stored in the selection unit, via the communications network to the conversion device identified by the Internet name (Guerin, col. 3, ll. 24-29).

17. Regarding claim 10, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, wherein the transferred information is an IP address (Guerin, col. 3, ll. 24-29) and, when an IP address specifically set up in the selection unit and identifying a conversion device is transferred, the corresponding conversion device is re-configured as the default conversion device (col. 5, lines 17-26).

18. Regarding claim 11, Bhatia and Guerin teach the method for setting up a connection via an IP-oriented network, the method further comprising the step of:

routing IP addresses subsequently transferred from a device to the router device via the currently set up default conversion device until a new IP address specifically set up in the selection unit is transferred to the router device (Guerin, col. 4, ll. 6-11).

19. Regarding claim 13, Bhatia and Guerin teach the router device wherein the selection unit is a server, a separate socket connection being provided between the device and the selection unit for transferring the information (Guerin, col. 3, ll. 41-45).

20. Regarding claim 14, Bhatia and Guerin teach the router device wherein the selection unit is designed according a Domain Name Service proxy (Guerin, col. 3, ll. 24-29).

21. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia and Guerin in view of Duvall et al. (U.S. 5,884,033), hereinafter referred to as Duvall.



Art Unit: 2142

22. Regarding claim 15, Bhatia and Guerin both teach the use of a router but are silent on the use of an IP address filter. However, Duvall teaches a filtering system used in order to ALLOW or BLOCK incoming or outgoing transmissions (col. 4, lines 22-36). It would have been obvious to one of ordinary skill in the art at the time of the applicants' invention to utilize the IP address filter as taught by Duvall in combination with the router device taught by Bhatia and Guerin. One of ordinary skill in the art would have been motivated to make such a combination in order to control the flow of incoming and outgoing packets through the router and have the ability to block transmissions when it is deemed necessary to do so (see Duvall, col. 4, lines 22-36).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

baa

  
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PRIMARY EXAMINER